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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Product Partners, LLC

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Serial No. 78269579

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Camille M. Miller of Cozen O'Connor for applicant.

Tracy L. Fletcher, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

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Before Quinn, Holtzman and Kuhlke, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Product Partners, LLC to register the mark 6 DAY EXPRESS ("6 DAY" disclaimed) for services ultimately recited as "weight reduction; [and] diet planning."[1]

[1] Application Serial No. 78269579, filed July 2, 2003, alleging a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to allege use setting forth dates of first use anywhere and in commerce of July 2003. The application originally included goods in Class 5 ("protein bars, and nutritional and dietary supplements"), but this class was deleted by an amendment filed on August 23, 2004.

The trademark examining attorney refused registration on the ground that the specimens fail to show use of the mark for the services recited in the application.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant states that its "diet plan is a quick weight loss plan." (Brief, p. 2). Applicant asserts that the original specimens and the additional specimen, both supported by a declaration of use in commerce prior to the filing of the amendment to allege use, show use of the mark in connection with the recited services. The original specimens comprise printouts of portions of applicant's website on the Internet, and applicant states that its mark appears on the same page that displays details about its services, that the price of the program is clearly displayed, and information on how to order the diet plan is literally just one click away. The additional specimen is a photocopy of applicant's instructional book that explains the diet plan, its weight loss benefits and nutritional benefits. According to applicant, the book "advertises the plan and instructs people on how to loose [sic] weight safely and effectively" and that the specimen "illustrate[s] counseling services on how to diet and lose

weight." (Brief, p. 3). Applicant contends that the specimens show use of its mark in connection with the sale and/or advertising of its weight reduction and diet planning services. Applicant argues, "a purchaser or potential purchaser can clearly identify the weight reduction or diet planning services provided under the 6 DAY EXPRESS diet plan and make a decision to purchase these types of weight reduction and diet planning services" and that "a purchaser can easily associate the services with the term 6 DAY EXPRESS." (Brief, p. 4). Applicant further asserts that "use of the phrase '6 DAY EXPRESS diet plan' in Applicant's specimens from its website is the exact type of specimen anticipated by and required by statutory requirements." (Reply Brief, p. 2). Applicant sums up by contending that it "is through this diet plan that Applicant provides the services of weight reduction and diet planning. Indeed, you cannot provide 'diet planning services' without a diet plan and it is this diet plan that sufficiently demonstrates Applicant's use of its mark as a service mark." Id.

The examining attorney maintains that neither the printed pages from applicant's website nor the copy of applicant's diet plan book show use of the mark in connection with the recited services. According to the

examining attorney, the specimens merely show that applicant is selling books that prescribe a plan for losing weight, together with related products such as nutritional supplements and exercise videos; the availability of information about dieting and weight loss contained within a book does not show the rendering of diet planning and weight reduction services. The examining attorney argues (Brief, unnumbered p. 3):

> None of these specimens identify diet planning or weight reduction services. In fact, the specimens merely show the mark used on a diet plan book that can be ordered online via the Applicant's website. There is no language in any of the specimens that offers to provide a service to help consumers lose weight or plan a healthy diet. There is no language offering weight loss program support form consultants or program leaders. Nor do any of the specimens describe personalized diet planning for an individual's weight loss goals or any other language that would make it clear that a service is being offered, rather than the goods themselves.

According to the examining attorney, "[d]iet planning services and weight reduction services are commonly understood to describe one-on-one or group meetings whereby purchasers are provided instruction and/or guidance in how to plan a healthy diet and in how to safely and effectively lose weight." (Brief, unnumbered p. 5). The availability

of information about dieting and weight loss contained within a diet plan book, the examining attorney maintains, does not show that applicant is providing diet planning and weight loss services. As the examining attorney argues, "the book does not evidence diet planning *services* or weight reduction *services* any more than a book about art history evidences educational services in the field of art history. (Brief, Id.; emphasis in original).

Trademark Rule 2.56(a) provides, in part, that an application alleging use must include one specimen showing the mark as used on or in connection with the sale or advertising of the services in commerce. Trademark Rule 2.56(b)(2) further specifies that a "service mark specimen must show the mark as actually used in the sale or advertising of the services." Section 45 of the Trademark Act provides, in part, that a service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...."

To be an acceptable specimen of use of the mark in the sale or advertising of the identified services, there must be a direct association between the mark sought to be registered and the services specified in the application, and there must be sufficient reference to the services in

the specimens to create this association. In re Monograms America Inc., 51 USPQ2d 1317 (TTAB 1999). It is not enough that the term alleged to constitute the mark be used in the sale or advertising; there must also be a direct association between the term and the services. In re Compagnie Nationale Air France, 265 F.2d 938, 121 USPQ 460, 461 (CCPA 1959) [“Nothing in the advertisement pertaining to the ‘SKY-ROOM’ identifies the air transportation service of appellant and there is no other evidence which reveals that the public considers ‘SKY-ROOM’ as an identifying mark of this airline.”]; In re Johnson Controls Inc., 33 USPQ2d 1318 (TTAB 1994) [“[T]he labels submitted as specimens with this application do not show use of the mark sought to be registered as a service mark for the custom manufacture of valves. If the application sought registration as a trademark for these fluid control products, these specimens would clearly be satisfactory, but that is not the issue here.”]; and Peopleware Systems, Inc. v. Peopleware, Inc., 226 USPQ 320 (TTAB 1985). See also In re Adair, 45 USPQ2d 1211 (TTAB 1997) [Mark TREE ARTS CO. and design may function as a mark for goods but specimen did not show the term used as a mark for the service of designing permanently decorated Christmas trees.]. The mark must be used in such a manner that it would be readily perceived as

identifying the source of such services. In re Advertising & Marketing Development, Inc., 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); and In re Metrotech, 33 USPQ2d 1049 (Com'r Pats. 1993). See TMEP §1301.04 (4th ed. rev. 2005).

The issue, thus, is whether applicant is using 6 DAY EXPRESS as a mark to identify the source of its weight reduction and diet planning services. The determination of whether applicant's specimens show the mark 6 DAY EXPRESS in connection with the sale or advertising of these services necessarily requires a consideration of the specimens.

The original specimens submitted for applicant's services, reproduced below, are web pages from applicant's website on the Internet.

competition.

Along with detailed meal plans tailored to your specific goals, you'll also receive vital information on:

- The Best Times to Eat
- How Much to Eat
- When to Work Out
- Foods and Liquids to Avoid
- The Importance of Protein Powders and Shakes
- The Safest And Best Methods to Achieve Successful Results

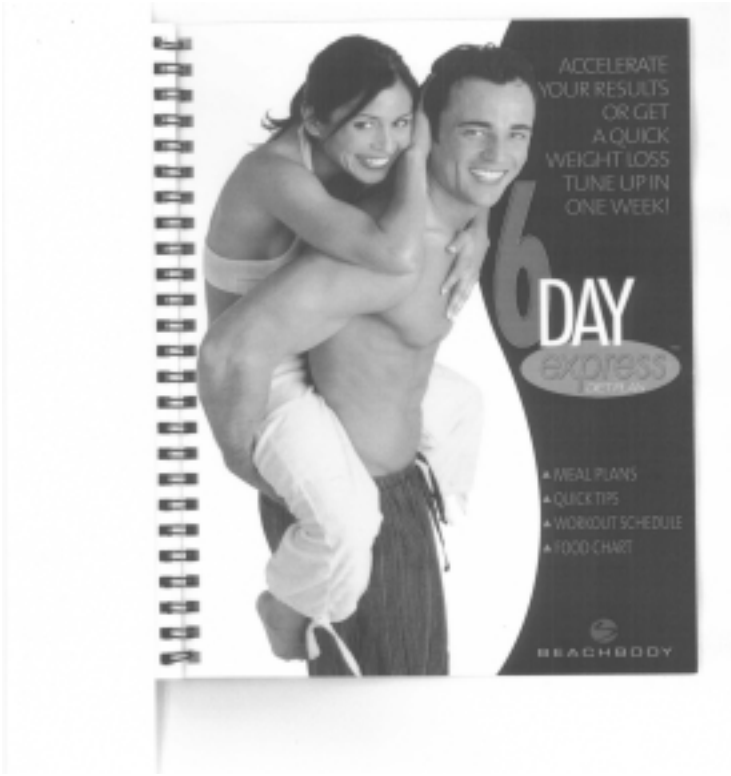
The 6-Day Express Diet Plan has demonstrated remarkable results, but should be used on limited occasions when slimming down quickly is a top priority. This is not a long term eating plan

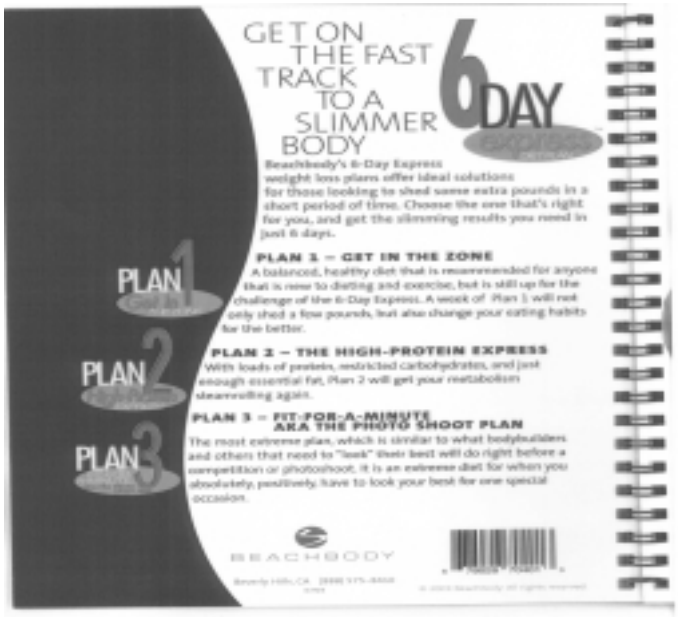
Seek the advice of your doctor before beginning any fast or diet program, Not advisable for pregnant or lactating women or anyone suffering from a medical condition.

Results will vary — you will continue to lose or gain weight depending on your exercise and eating habits.

To order by phone, call: 1 (800)-924-1919

Applicant's additional specimens comprise a photocopy of applicant's diet plan. The front and back cover of applicant's plan is reproduced below.





Our primary reviewing court has held that a "service" is "the performance of labor for the benefit of another." In re Canadian Pacific Ltd., 754 F.2d 992, 994, 224 USPQ 971, 973 (Fed. Cir. 1985). The recited services involved herein clearly are a "service" under this definition, and we will presume that applicant in fact renders such services. However, the issue in this case is not whether the recited services constitute "services," or whether applicant in fact provides those services. Rather, the issue is whether the specimens of record demonstrate use of the mark as a service mark for those services.

As noted above, Trademark Rule 2.56(b)(2) provides that "[a] service mark specimen must show the mark as actually used in the sale or advertising of the services." In this case, applicant's specimens clearly are not advertisements for the recited services because they do not show the requisite direct association between the mark and the recited services. See In re Adair, supra; and In re Johnson Controls, Inc., supra. The original Class 44 specimen, the portions of applicant's website, is an advertisement for applicant's diet plan book, not an advertisement for the recited services; indeed, the advertisement contains no reference to the recited services. Likewise, the diet plan book covers themselves

and the content contained within are not advertisements for the recited services, because they make no reference to the services per se. The text on the front cover of the book includes references to "meal plans, quick tips, workout schedule and food chart." The book's back cover describes applicant's diet plan as follows: "Get On The Fast Track To A Slimmer Body. Beachbody's 6-Day Express weight loss plans offer ideal solutions for those looking to shed some extra pounds in a short period of time. Choose the one that's right for you, and get the slimming results you need in just 6 days." These references are to the content of the diet plan book itself; they are not advertisements for the recited weight reduction and diet planning services. As best we understand it, however, applicant contends that even if the specimens do not show use of the mark in the advertising of the services (because they make no direct reference to the services), they nonetheless are adequate service mark specimens because they show the mark as it is used in the course of the actual performance or rendering of the services. Where the specimens show use of the mark in the rendering (as opposed to the advertising) of the services, a reference to the services on the specimens themselves may not be necessary. In re Metriplex Inc., 23 USPQ2d 1315 (TTAB 1992); In re Eagle Fence Rentals, Inc.,

231 USPQ 228 (TTAB 1986); and In re Red Robin Enterprises, Inc., 222 USPQ 911 (TTAB 1984). It would appear to be applicant's contention that its services are rendered through the content of its diet plan.

We are not persuaded by this argument. The Board rejected a very similar argument in the case of In re Landmark Communications, Inc., 204 USPQ 692 (TTAB 1979). In that case, the applicant sought to register the mark THE DAILY BREAK as a service mark for "educational and entertainment services comprising the collection, printing, presentation and distribution of a newspaper section of cultural and leisure information" on various topics. The specimen of use submitted by the applicant was a copy of the newspaper section which bore the mark as its title, as published in the applicant's newspaper. The Board rejected the applicant's contention that, in publishing the newspaper section, it was performing or rendering the recited services, or any service. "Applicant sells goods, not services for every individual reader." 204 USPQ at 696. Similarly in this case, in publishing its diet plan, applicant is producing and selling a finished product, not performing or rendering a service to the order of or for the benefit of individual purchasers. The purchaser is not receiving weight reduction and diet planning services from

applicant, but rather is purchasing an informational/educational diet plan created by applicant, i.e., a product. Just as a newspaper publisher is not rendering educational or informational services merely by publishing a newspaper section with educational content, applicant herein is not rendering weight reduction and diet planning services merely by publishing its diet plan. In the above-cited cases of In re Metriplex, In re Eagle Fence, and In re Red Robin, the specimens were deemed acceptable because they showed how the respective marks were being used in connection with the recited services as the services were being performed, i.e., during the transmission of data via computer in Metriplex, during the rental of fencing in Eagle Fence, and during the performance of entertainment services in Red Robin. In the present case, by contrast, any activity or labor performed by applicant in producing and publishing its diet plan had already concluded by the time the purchaser buys the diet plan; the purchaser is not paying for an ongoing provision of services by applicant, but rather is paying for a finished product, i.e., the diet plan. Again, the issue here is not whether applicant is in fact rendering the weight reduction and diet planning services recited in the application, but rather whether the specimens of record

demonstrate service mark use of the mark in connection with such services. For the reasons discussed above, we find that they do not.

Decision: The refusal to register is affirmed.